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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,473	01/29/2001	Michel Philippe	05725.0834	6832

22852 7590 04/23/2002

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EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/23/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/770,473

Applicant(s)

PHILIPPE ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 31-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-30 in Paper No. 6, submitted 31 January 2002 is acknowledged. The traversal is on the ground(s) that the examination of all claims would not present a serious burden because the subject would appear to overlap. This is not found persuasive because the inventions are distinct, as discussed in a previous Office Action. The search for the two groups is not co-extensive, particularly with respect to the non-patent literature. The requirement is still deemed proper and is therefore made FINAL.
2. Claims 31-59 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

### ***Double Patenting***

3. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39 and 52 of copending Application No. 09/770,472. Although the conflicting claims are not identical, they are not patentably distinct from each other because the co-pending claims are drawn to processes and compositions comprising the same ingredients as the currently claimed invention in an anti-seborrheic shampoo. It is obvious to use an anti-seborrheic shampoo in a process for treating conditions associated with seborrhea.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 1 is rejected for being vague due to the phrase "disorders associated with seborrhea, and disorders associated with microorganisms of the genus *Propionibacterium*". It is unclear if such disorders are limited to disorders that are actually caused by seborrhea or the particular microorganisms. In other words, the metes and bounds suggested by the limitation "associated with" are unclear.

7. Claims 1, 4, 5, 10, 12, 13, 16, 17, 21, 22, 23, and 24 are rejected for being vague due to the phrase "hydrocarbon-based radicals". It is unclear if such radicals are limited to hydrocarbons, i.e. C and H only, or can be substituted with other components. If the radicals contain other components besides C and H, they no longer can be considered hydrocarbons. The claims can be clarified by removal of the term "hydrocarbon-based".

8. Any remaining claims are rejected for depending from an indefinite base claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-3, 6-9, and 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Klein et al (US Pat. 4,147,782). Klein discloses pharmaceutical preparations for the treatment of acne, chronic oily skin, and other skin ailments such as dermatitis (see abstract and col. 1, lines 5-15). The compositions are disclosed as potent antiseborrheic agents (see col. 4, lines 40-55). The compositions include N-acyl esters of sarcosine (see col. 1, lines 46-62).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
13. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morelle et al (US Pat. 4,089,954) in view of Marx (US Pat. 5,898,037).
14. Morelle teaches metal salts of fatty acid derivatives of amino acids. Morelle teaches that lipoaminoacids are known to easily go through tissues and cellular membranes due to their specific structure (see col. 1, lines 24-35). Morelle further teaches that the metal salts of lipoaminoacids have the same characteristic of compatibility with biological tissues (see col. 1, lines 30-35), suggesting that the compositions can be used in therapies where the particular metals such as magnesium are important (see col. 1, line 65 through col. 2, line 16). The reference lacks a teaching of the use of the compounds for treating conditions such as acne.
15. Marx teaches the use of magnesium in topical formulations for treating conditions such as acne (see abstract). Marx teaches that the topical use of magnesium is useful in treating a number of conditions, including acne (see col. 3, lines 1-10).
16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the methods of using the compositions of Morelle by the use of magnesium compositions in treating acne as taught by Marx in order to benefit from the increased compatibility with biological tissue for such treatments.

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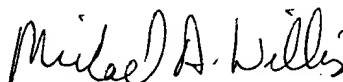
**Conclusion**

17. The elected species of formula I in which  $R1=C8H17-CH=CH-C8H16-$ ,  $X=-NH-$ ,  $R2=H$ ,  $R3=CH3$ , and  $N=9.8$  is free of the art, with the exception of the double-patenting rejection as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on Mon. to Fri. from 9 a.m. to 5:30 p.m.

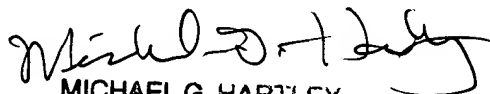
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis  
Examiner  
Art Unit 1617

April 22, 2002



MICHAEL G. HARTLEY  
PRIMARY EXAMINER